IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Francis et al.**	§	
	§	Group Art Unit: **2178**
Serial No. **09/543,952**	§	
	§	Examiner: **Vaughn, Gregory J.**
Filed: **April 6, 2000**	§	
	§	Attorney Docket No.: **RSW9-2000-0008-US1**
For: **System, Apparatus and Method for Transformation of Java Server Pages into PVC Formats**	§	

Commissioner for Patents
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PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on August 17, 2007.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461.

RESPONSE TO EXAMINER'S ANSWER

Single Server not Shown Performing the Recited Steps

In response to Appellants' arguments that the art of record does not teach, suggest or provide other motivation to modify the references to provide a single server for performing all of the steps recited in Claim 1, the Examiner states on page 11 of the Examiner Answer that 'Hawkins discloses a "Web" server and a "Proxy" server. Sharing services among **servers** is well known in the art' (emphasis added by Appellants). Appellants urge that this is exactly the point – the cited art contemplated a *plurality* of servers being used to provide the steps recited in Claim 1. A more elegant solution is provided by the features of Claim 1 using a *single* server (where the requested JSP file is stored).

The Examiner further opines that Hawkins contemplates alternative embodiments, as Hawkins recites: 'The following describes an embodiment of the invention where a user's computer is substituted for the base station 170 and the proxy server (column 265, lines 11-14)'. Even assuming this is true, such assertion still does not establish a prima facie showing of obviousness that *all* steps recited in Claim 1 are performed by a *single server*, as claimed, as there is still an *additional web server* 140 (Hawkins Figure 1, element 140).

It should be noted that a fundamental premise of the teachings of the primary Hawkins reference is directed to providing a system having a *distributed web site* (see, e.g., Hawkins Abstract). Thus, the very foundation upon which Hawkins' system is premised is a distributed environment with multiple servers. Such a distributed system is diametrically opposed to the single server processing per Claim 1, and thus a person of ordinary skill in the art would not have been motivated to modify such teachings in accordance with the missing claimed features of Claim 1, nor would such change be a predictable result with respect to the teachings of the cited Hawkins reference as such teachings are keen on providing a plurality of servers in a distributed fashion.

File to be Transformed Does Not Contain Executable Program Code

The Examiner alleges that Hawkins describes Java applets that reside on the client or are served to the client by a server, and hence Hawkins discloses executable program code type files (Java applets) that are served to the client by a server. It is urged that even assuming this to be true, the combined teachings do not teach or suggest that a file *being transformed* by Hawkins' transformation process contains executable code, as this description by Hawkins of applets is with respect to an unrelated passage that is not directed to the Hawkins' file transformation process. In fact, Hawkins expressly teaches away from using applets in the Hawkins distributed web site due to problems associated with such code being very specific to a given end user device (Hawkins col. 3, lines 20-25). Thus, a person of ordinary skill would not have been motivated to modify the teachings of the cited Hawkins references to include executable code in files being transformed by a server, as claimed.

Selective Conversion of Tags Based on Tag-type Is Not Shown

In rebuttal to Appellants showing that the combined teachings of the cited references do not teach selective tag conversion, the Examiner states that 'Encryption inherently includes a second decryption process that unmasks the protected elements'. It is urged that this aspect of the claim is not directed to a decryption process (but instead is directed to a selective conversion and masking process), so even if decryption were inherent, a prima facie showing of obviousness has not be established with respect to the claimed features of "masking the JSP tags", "converting non-masked tags in the original JSP file into PvC device specific format tags", "unmasking the JSP tags", and "storing a transformed JSP file containing the PvC device specific format tags and the JSP tags". As can be seen, some tags are masked and unmasked (JSP tags), and other tags are converted (non-masked tags). Hawkins teaches that all tags are converted to binary in order to compress them.

No Proper Motivation for Reference Combination

The Examiner states that it would have been obvious to one of ordinary skill in the art to use JSP style program code, as taught by Hunter, in the program code enabled files of Hawkins, because Hunter teaches that the functionality and syntax of JSP's resembles other server page

languages. As described above, Hawkins expressly teaches away from using or transforming programming code. Instead, Hawkins describes that predefined applications are stored at the client device, with *responses to queries being transformed* (col. 3, lines 33-48). Thus, it would not have been obvious to a person of ordinary skill in the art to somehow modify the Hawkins teachings to include two different types of data being processed in a transformation process, with one type of data being device specific tags and another type of data being JSP tags, as Hawkins explicitly disdains downloading of executable code to his portable device.

Claims 6, 7, 13, 14, 20, 21, 27 and 28

In responding to Appellants' detailed analysis regarding numerous missing claimed features recited in Claims 6, 7, 13, 14, 20, 21, 27 and 28, the Examiner apparently agrees that such features are not taught by the cited references because the Examiner now takes the position that these claimed features are 'inherent' in a parsing process. Appellants urge that such a broad-brushed inherency assertion is not a proper basis for a 35 USC 103 rejection. In any event, these claimed features are not inherent because there are numerous and substantial ways to parse a file and the claimed features recited in these claims are directed to a specific, particular way of parsing a JSP file. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence `must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "`probabilities or possibilities.'" *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock*, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*,

666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939).

Quite simply, even if inherency were being properly used in a 35 USC 103 rejection[1], the Examiner has failed to meet their burden on establishing *why* such features are inherent. Thus, it is urged that the Examiner has failed to properly establish a prima facie showing of obviousness with respect to Claims 6, 7, 13, 14, 20, 21, 27 and 28 by a mere – and unsubstantiated - allegation that all of the features recited in all of these claims are inherent in a parsing process.

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[1] The proper analysis of claim rejections under 35 U.S.C. 103 should instead focus on (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) objective evidence relevant to the issue of obviousness. *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57526 (U.S. 2007).

CONCLUSION

It is therefore respectfully requested that the rejection of all pending claims be reversed due to the numerous errors identified in Appellants' Appeal Brief and this Reply Brief.

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